

REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims supersedes any previous listing. Favorable reexamination and reconsideration are respectfully requested in view of the preceding amendments and the following remarks.

Claim Status/Amendments

Claim 1-23 remain pending in this application. Claims 8 and 18 have been amended in a manner to overcome the indefiniteness issue raised in paragraph #8 of this Office Action. These amendments overcome the 35 USC § 112 first paragraph rejection on page 4 of this Office Action. The subject matter of claims 5 and 15 have been transferred to independent claims 1 and 15 respectively, and claims 5 and 15, have been cancelled.

Rejection under 35 USC § 132(a)

The objection under 35 USC § 132(a) is traversed. To assert that "a computer readable medium" in a claim which is directed to "a computer program" is new matter is totally untenable. Where else are computer programs stored or even exist for the purposes of being run? Is it not well known that programs are stored in some form of memory for running in a processor? What else would one of skill in the art expect to be capable of storing a program of the disclosed nature?

"A patent need not teach, and preferably omits, what is well known in the art." *Spectra-Physics, Inc v. Coherent, Inc.*, 827 F.2d 1524, 3 USPQ 1737 (Fed. Cir. 1987)." M.P.E.P. § 2164.01.

Every word in a claim need not be found *per se* in the specification, New matter may be broadly defined as disclosure material not already explicitly, implicitly, inherently or intrinsically included in an application as of its effective filing date. Added matter in an application is not legally prohibited by statute as new matter when it merely makes explicit that which was originally implicit, inherent or intrinsic in the original disclosure. New matter may take the form of additions, deletions or modifications, subsequent to the initial filing of an application, to any part of the disclosure which includes the drawing, specification and claims. Matter may not be added to an application for the purpose of supplementing an otherwise inadequate disclosure of the invention in order to provide sufficient support for the claims. Any claim which requires new matter for its support is invalid. Added matter upon which no claim depends for support may

have to be cancelled if objected to -by the Examiner as new matter but otherwise imposes no legal liability even if actually entered in the application. See generally, *In re Davies*, 475 F.2d 667, 177 U.S.P.Q. 381 (C.C.P.A. 1973), and *Rhone—Poulenc v. Dann*, 504 F.2d 983, 184 U.S.P.Q. 196. (4th Cir. 1974).

Attention is called to the fact that the specification on page 5 first two full paragraphs disclose processors, hardware/architecture. This is sufficient to indicate the presence of a memory in which the program could be/would be stored.

Rejection under 35 USC § 101

This rejection of claims 11-23 is based on the position that apparatus “could be” (might possibly be) emulated by a program (viz., run in a computer) and therefore is not apparatus (as claimed) but a program and therefore non-statutory subject matter. All because of this - might possibly be – type position. Applicant submits that the rejection is improper and could not even be made under § 112. That is to say, the “might be” basis for rejecting apparatus claims “might be” right and “might be” wrong. What if the claimed apparatus is not a program and is really hardware?

The basis for the blanket holding that programs are non-statutory is not advanced in this rejection. The MPEP or better still, some legal basis for this holding needs to be cited. The Applicant also questions as to how the examiner envisages that this rejection could be overcome. The claim sets forth an apparatus how does the examiner envisage that claims of this nature could be amended to overcome this type of rejection?

In a brief telephonic conference with the Examiner, the Examiner suggested that adding a limitation of a processor to the claims may help. However, in light of the position taken that the “a computer readable medium” recited in claim 21 is “new matter” (allowing the limitation to be improperly ignored) this hardly seems to be effective.

As to this new matter issue, Applicant points out that patent specifications are not written for those in primary school but those of skill in the related art – see MPEP 2164.05(b) and the comments re this issue *supra*.

Rejections under 35 USC § 102

The rejection of claims 1-4, 6, 8-14, 16 and 18-23 under 35 USC § 102(e) as being unpatentable over Hellman et al, is traversed.

In this response, subject matter which is admitted as not being anticipated have been transferred from claims 5 and 15, into claim 1 and 11 respectively. This moots the anticipation rejection.

Rejection under 35 USC § 103

The rejection of 5, 7, 15 and 17 under 35 USC § 103(a) as being unpatentable over Hellman et al, and Sandham, is respectfully traversed.

Sandham is cited in an attempt to compensate for the acknowledged lack of disclosure of the claimed mapping accounting for differences in endianness between the source and target model. However, it is submitted that the hypothetical person of ordinary skill would not be particularly motivated to make the combination/transfer of teachings purported to be obvious in this rejection. Sandham is directed to a problem commonly encountered by emulation systems, which run identical software on different computer processor chips wherein format incompatibility is encountered.

Emulation systems are available which enable software (such as an operating system or an application program) of one endian format to operate on hardware of an opposite endian format. Generally, systems of this type convert each word between endian representations on a word-by-word basis. This conversion, when required frequently, introduces a significant overhead into the time required to perform a given task.

The invention disclosed in Sandham is directed to providing a method for emulating a processor of a first type which observes a first convention for ordering the significance of bytes within words on a second type of processor which observes a second convention for ordering the significance of bytes within words.

It is not seen how this relates to Hellman et al. which can be used to derive executable code that transforms source relational databases into the target relational databases. In a one embodiment, the Hellman et al. invention creates a Java program that executes the SQL query using the JDBC (Java Database Connectivity) library. In an alternative embodiment the Java program manipulates the databases directly, without use of an SQL query. No particular drawback appears to be disclosed and therefore nothing to lead the hypothetical person of ordinary skill to look abroad to other patents for modification/problem solution.

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obviousness was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

Indeed, when a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. *See In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). Although the suggestion to combine references may flow from the nature of the problem, *see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), the suggestion more often comes from the teachings of the pertinent references, *see In re Sernaker*, 702 F.2d 989, 994, 217 USPQ 1, 5 (Fed. Cir. 1983), or from the ordinary knowledge of those skilled in the art that certain references are of special importance in a particular field, *see Pro-Mold*, 75 F.3d at 1573 (citing *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 n.24, 227 USPQ 657, 667 n.24 (Fed. Cir. 1985)). Therefore, "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" *See In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)).

In this situation, it is not seen that there is a disclosed problem to be solved or anything in either of the references which would lead toward the proposed combination of teachings. Indeed, it appears to be nothing more than a "its known so its obvious" type of rejection. That is to say, the motivation to modify an ontology based arrangement so that it can run on different types of processors, hardly seems suggested by the disclosure of the two documents taken as a whole.

It is therefore submitted that a prima facie case of obviousness has not been established, and that the rejection should be withdrawn.

Conclusion

It is respectfully submitted that the claims as they have been amended are allowable over the art which has been applied in this Office Action. Favorable reconsideration and allowance of this application are courteously solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 08-2025 and please credit any excess fees to such deposit account.

Respectfully submitted,
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